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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/565,780	07/28/2006	Kentarou Kanae	285029US0PCT	7604
22850 7590 02/12/2009 OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			EXAMINER NUTTER, NATHAN M	
			ART UNIT	PAPER NUMBER
			1796	
			NOTIFICATION DATE	DELIVERY MODE
			02/12/2009	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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<b>Office Action Summary</b>	<b>Application No.</b> 10/565,780	<b>Applicant(s)</b> KANAE ET AL.	
	<b>Examiner</b> Nathan M. Nutter	<b>Art Unit</b> 1796	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 9-30 is/are pending in the application.  
     4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
     a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)            | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. ____.                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>1-06, 4-06, 10-06</u> .                                       | 6) <input type="checkbox"/> Other: ____.                          |

## **DETAILED ACTION**

### ***Specification***

The disclosure is objected to because of the following informalities:

A substitute specification in proper idiomatic English and in compliance with 37 CFR 1.52(a) and (b) is required. The substitute specification filed must be accompanied by a statement that it contains no new matter.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 9-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 9, 10, 21 and 26, the term "type" renders the claims indefinite because the claims include elements not actually disclosed (those encompassed by "type"), thereby rendering the scope of the claims unascertainable. See MPEP § 2173.05(d).

Claim 13 recites the limitation "(A2)" in line 2. There is insufficient antecedent basis for this limitation in the claim. Nothing is recited in claim 9 to correspond with "(A2)."

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Claim 18 recites the limitation "(A1)" in line 2. There is insufficient antecedent basis for this limitation in the claim. Nothing is recited in claim 10 to correspond with "(A1)."

Claim 23 recites the limitation "(A2)" in line 2. There is insufficient antecedent basis for this limitation in the claim. Nothing is recited in claim 21 to correspond with "(A2)."

Claim 28 recites the limitation "(A1)" in line 2. There is insufficient antecedent basis for this limitation in the claim. Nothing is recited in claim 26 to correspond with "(A1)."

### ***Double Patenting***

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 9-30 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 17-34 of copending Application No. 10/588,198 (US 2007/0173591) Kanae et al. Although the conflicting claims are not identical, they are not patentably distinct from each other because the copending application claims a thermoplastic elastomer composition that may comprise an ethylene- $\alpha$ -olefin based copolymer, which may be an oil extended elastomer thereof (claim 18 of the copending application), with a polyolefin-based resin, and a hydrogenated block copolymer of either a conjugated diene compound or a conjugated diene and a vinyl aromatic compound (claim 20 of the copending application). Noting the Specification to provide the proper scope of metes and bounds to the claims, the polyolefin based resin may be crystalline polyethylene at paragraphs [0067] and [0070], the hydrogenated resins may be employed together at paragraph [0105], and other resins, including crystalline polypropylene may be employed. See paragraph [0081].

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9-30 are provisionally rejected under 35 U.S.C. 103(a) as being obvious over copending Application No. 10/588,198 (US 2007/0173591) Kanae et al, which has a common assignee and two inventors with the instant application. Based upon the earlier effective U.S. filing date of the copending application, it would constitute prior art under 35 U.S.C. 102(e) if published or patented. This provisional rejection under 35 U.S.C. 103(a) is based upon a presumption of future publication or patenting of the conflicting application.

The reference claims a thermoplastic elastomer composition that may comprise an ethylene- $\alpha$ -olefin based copolymer, which may be an oil extended elastomer thereof (claim 18 of the copending application), with a polyolefin-based resin, and a hydrogenated block copolymer of either a conjugated diene compound or a conjugated diene and a vinyl aromatic compound (claim 20 of the copending application). Noting the Specification to provide the proper scope of metes and bounds to the claims, the polyolefin based resin may be crystalline polyethylene at paragraphs [0067] and [0070], the hydrogenated resins may be employed together at paragraph [0105], and other resins, including crystalline polypropylene may be employed. See paragraph [0081].

This provisional rejection might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the copending application was derived from the inventor of this application and is thus not the invention "by another," or by a showing of a date of invention for the instant application prior to the effective U.S. filing date of the copending application under 37 CFR 1.131. This rejection might also

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be overcome by showing that the copending application is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(I)(1) and § 706.02(I)(2).

### ***Claim Rejections - 35 USC § 102/103***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 9-30 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Morikawa et al (US 2002/0177659).

The reference teaches the manufacture of a thermoplastic elastomer composition that may comprise an ethylene- $\alpha$ -olefin based copolymer, which may be an oil extended elastomer thereof, with a polyolefin-based resin, and a hydrogenated block copolymer of either a conjugated diene compound or a conjugated diene and a vinyl aromatic compound. Note Table 1 at pages 5 and 6 and paragraph [0048] which shows the employment of an oil extended ethylene- $\alpha$ -olefin elastomer. Note paragraph [0027] for percentages of constituents that overlap those recited herein. The reference teaches the employment of “a plural of block copolymers,” including those recited herein, at paragraph [0024]. Further note paragraphs [0016]-[0021] for the block copolymers employed, including (C) at paragraph [0016] and (D) at paragraph [0021]. At paragraphs [0011]-[0012] the polyolefin based resin may be crystalline polyethylene, and may

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comprise a crystalline polypropylene. The employment of the mineral oil is shown at paragraph [0029].

The specific parts by mass for the components hydrogenated block copolymers (C) and (D) are not shown by the reference, only that two or more may be employed. The reference does provide some guidance at paragraph [0027] wherein the mass of the EAO copolymer, "present in an amount of 40 to 94% by mass" and the sum of the block copolymer constituent, which at paragraph [0024] and [0029] may comprise both (C) and (D) together, and the crystalline polyethylene "amounts to 6 to 60% by mass," and the crystalline fraction thereof being "20 to 80% by mass." There is clear overlap of compositional limitations for the totals. While the specific amounts have not been attached to the specific block copolymers, the disclosed range would clearly embrace up to 20 parts by mass of each and of the crystalline polyethylene.

As such, the instant claims would be at least obvious, if not anticipated, by the teachings of the reference.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nathan M. Nutter whose telephone number is 571-272-1076. The examiner can normally be reached on 9:30 a.m.-6:00 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James J. Seidleck can be reached on 571-272-1078. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Nathan M. Nutter/  
Primary Examiner, Art Unit 1796

nmn

8 February 2009